

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

I. Disposition of Claims

Claims 1-5 and 10-13 are pending in this application. Claims 1, 10, and 12 are independent. The remaining claims depend, directly or indirectly, from claims 1, 10, and 12. By way of this reply, claims 1, 10, and 12 have been amended.

II. Claim Amendments

Claims 1 and 10 have been amended to recite the transmission of partial data of the desired page to be printed after the pages to be printed have been set based on the structure of the resource from a server. No new matter has been added by way of these amendments as support for these amendments may be found, for example, in Figure 3 of the present application. Claim 12 has been rewritten in independent form.

III. Objection(s) to the Claims

Claims 12 is objected to under 37 CFR § 1.75(c) as being in improper dependent form for failing to further limit the subject matter of a previous claim. Particularly, the Examiner stated that the applicant is required to cancel the claim, or amend the claim to place it in proper dependent form, or rewrite the claim in independent form. By way of this reply, claim 12 has been rewritten in independent form. Accordingly, withdrawal of

the objections to this claim is respectfully requested.

IV. Rejection(s) under 35 U.S.C § 112

Claims 1-5 and 10-12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For the reasons set forth below, withdrawal of the rejection is respectfully requested.

The Examiner objected to the limitations “the second response” and “the response” in independent claims 1 and 10 of the present application as having insufficient antecedent basis. By way of this reply, claims 1, 10, and 12 have been amended to recite “a response” and “a second response” instead of “the response” and “the second response.” Accordingly, amended independent claims 1, 10, and 12 are not indefinite on these grounds, and withdrawal of this rejection is respectfully requested.

V. Rejection(s) under 35 U.S.C § 102

Claims 1, 2, 3, 10, and 13 of the present application were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,628,413 issued to Lee (hereinafter “Lee”). For the reasons set forth below, this rejection is respectfully traversed.

The present invention is directed to shortening the time required for obtaining a resource from a server and printing such resource, as well as to efficiently using the network resources. The present invention is a printer characterized in that it makes a first request for obtaining a resource (document), determines the structure (page layout) of the resource based on a first response to the first request, sets pages to be printed (range of

obtained data) based on the structure of the determined resource, makes a second request for obtaining the structural data within the set pages to be printed, generates print data based on the second response to the second request, and prints the resource based on the generated print data.

Accordingly, amended independent claims 1 and 10 require, in part, a second request means which generates a request message for requesting the transmission of *partial data* of the desired page to be printed after the pages to be printed have been set *based on the structure of the resource from the server*. Thus, as shown in figure 3 of the present application, as a printer successively sets pages to be printed according to the progress of the printing, the printer requests the transmission of the data of the set pages to be printed, and receives and prints such data. Therefore, *it is not necessary for the printer to obtain the entire source at once* and the memory need not be increased more than necessary even upon directly obtaining the resource from the server.

Lee, in contrast to the present application, fails to disclose at least the limitations of independent claims 1 and 10 discussed above. Lee is directed to a method and system for printing documents based on Java commands. As shown in Figure 2, Lee discloses a Java printer 110 which creates a *default pagination* based on the characteristics of the printer. Lee fails to disclose or otherwise teach the requesting of the transmission of partial data of the desired page to be printed as required by amended independent claims 1 and 10 of the present application.

In view of the above, Lee fails to show or suggest the present invention as recited in independent claims 1 and 10. Thus, independent claims 1 and 10 of the present

application are patentable over Lee. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

VI. Rejection(s) Under 35 U.S.C § 103

Claims 4, 5, 11, and 12 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of U.S. Patent No. 6,011,905 issued to Huttenlocher (hereinafter "Huttenlocher"). For the reasons set forth below, this rejection is respectfully traversed.

Like Lee discussed above, Huttenlocher fails to disclose all the limitations of independent claims 1, 10, and 12 of the present application or supply that which Lee lacks. Huttenlocher, which is directed to a method in which first and second representations of a document are provided, for example, by being made available on one or more server computers connected to a computer network, such as the internet or a corporate intranet (*see* Huttenlocher, Abstract), is altogether silent as to generating a request message for requesting the *transmission of partial data* of the desired page to be printed after the pages to be printed have been set based on the structure of the resource as required by the claimed invention. Accordingly, Huttenlocher fails at least to disclose those limitations of independent claims 1, 10, and 12 of the present application not disclosed in Lee.

Further, Applicant notes that there is no motivation to combine the teachings of Lee and Huttenlocher. There must be a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must an indication within the prior

art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used as a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

Lee is directed to a method and system for printing documents based on Java commands. *See* Lee, Abstract; column 2, lines 35 – 55. On the other hand, Huttenlocher is directed to data compression techniques suitable for document image rendering and transmission and structured document representations suitable for rendering into printable or displayable document raster images, such as bitmapped binary images or other binary pixel or raster images. *See* Huttenlocher, column 1, lines 13 – 20. The Examiner suggests that these references are combinable because it would be obvious to one skilled in the art to modify Lee to include the teachings of Huttenlocher so as to allow one skilled in the art to “obtain a resource from the server and discriminate different formats and means for generating print data to be printed.” *See* Office Action of April 27, 2004 (citing Huttenlocher, Figure 10). However, there is no suggestion, either explicitly or implicitly, in Lee to have the recited feature of Huttenlocher, and it is clear to one skilled in the art that Lee and Huttenlocher are wholly unrelated. Thus, there is no suggestion within either Lee or Huttenlocher to incorporate, or otherwise combine, the teachings of one another.

In view of the above, (i) Lee and Huttenlocher, whether considered separately or in combination, fail to disclose all the limitations of independent claims 1, 10, and 12 of the present application, and (ii) Lee and Huttenlocher are not properly combinable in a rejection against the present application. Thus, independent claims 1, 10, and 12 of the

present application are patentable over Lee and Huttenlocher. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

VII. Conclusion

Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 04783.010001).

Respectfully submitted,

Date: 7/22/04



Jonathan P. Osha, Reg. No. 33,986
Osha & May L.L.P.
One Houston Center, Suite 2800
1221 McKinney Street
Houston, TX 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778